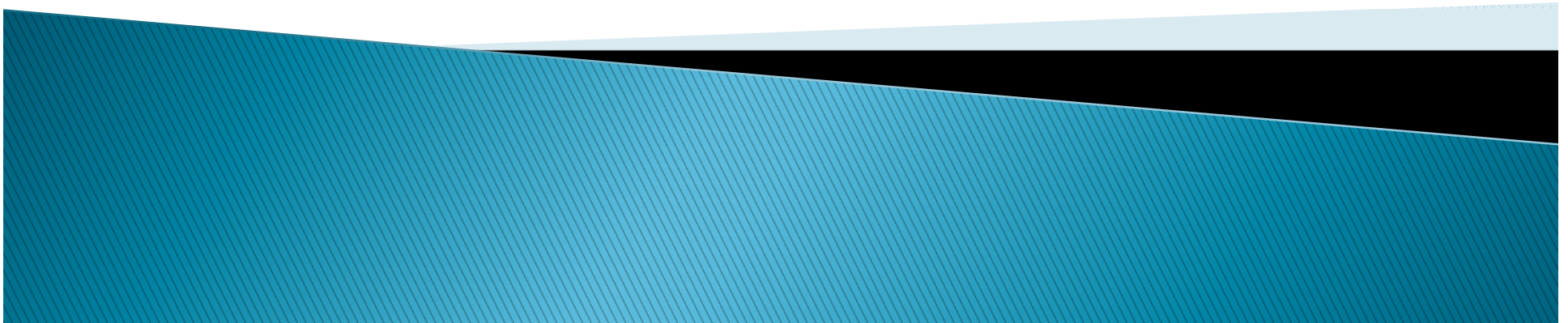


USPTO's Interim Eligibility Guidance:

4 Observations + 1 Story

Robert R. Sachs
Fenwick & West



Words of Promise...

“This Interim Eligibility Guidance offers a comprehensive view of subject matter eligibility in line with *Alice Corp*, *Myriad*, *Mayo*, and the related body of case law, and is responsive to the public comments received pertaining to the March 2014 Procedure and the June 2014 Preliminary Instructions.”

1. Evidence and Reasoning

- ▶ Examiners must provide factual evidence and reasoning on the record to support 101 rejection
- ▶ ABA, AIPLA, BSA, CCIA, IBM, IEEE, IPO, Public Knowledge, Microsoft, SAS, Trading Tech + 7 commentators
- ▶ Follow *Bilski–Alice* and cite references to show “abstract idea” is “fundamental”
- ▶ Interim Guidance: NO MENTION AT ALL

The IEEE Says It Best:

“Each of the latter two showings must be supported by “substantial evidence” in the sense of the Administrative Procedure Act. The Action must cite to either a statement in the applicant’s specification or in a third-party reference, to support both “long” standing and prevalent. Final instructions must make clear that examiner explanation or argument is not “substantial evidence.” Final instructions should make clear that an examiner’s personal assertion that something is “well known” under MPEP § 2144.03 is not relevant to the evidentiary showings required for § 101.”

2. Focus on Preemption

- ▶ Preemption is the core concern of § 101.
 - “We have described the concern that drives this exclusionary principle as one of preemption.”
Alice
- ▶ ACLU, AIPLA, BSA IEEE, Microsoft, Public Knowledge, Trading Tech, + 6 commentators

Both Sides Agree: Preemption Matters

- ▶ “When determining whether a claim is directed to an abstract idea, the examiner should be instructed to consider the preemptive effect of the claim.” J. Muskin
- ▶ “In particular, the PTO should advise that (1) examiners should apply the Court’s preemption doctrine in evaluating patent claims involving abstract ideas.” Public Knowledge

Interim Guidance:

Non-preemption is a side effect

- “If the claim recites an element or combination of elements that amount to significantly more than that exception, consider whether those additional elements also amount to significantly more for the other claimed exception(s), which ensures that the claim does not have a pre-emptive effect with respect to any of the recited exceptions.”
- p.24

3. Real Software Claim Examples

- ▶ Guidance must include examples of eligible vs. ineligible claims with explanations
- ▶ ABA, AIPPI, JIPA, IBM, Microsoft, Public Knowledge + 7 commentators
- ▶ Specific claim examples given by IBM, Trading Technology, R. Molitors
- ▶ Interim Guidance: Still waiting...

Trading Tech. Examples

- 👎 Claim 1. A method for matching buyers and sellers comprising: receiving orders and matching orders of buyers with sellers.
- 👎 Claim 2. A method for matching buyers and sellers comprising: using a computing device to receive orders and match orders of buyers with sellers.
- 👍 Claim 3. A method for matching buyers and sellers comprising: receiving orders, time-stamping the orders, and matching orders of buyers and sellers using a pro-rata matching algorithm.
- 👍 Claim 4. A method for matching buyers and sellers comprising: receiving orders, time-stamping the orders, and matching orders that were received during a 1 minute window of time according to the time-stamps.

4. Abstract Ideas are “Big Ideas”

- ▶ Abstract Ideas must be fundamental to a domain, both long in use and prevalent.
- ▶ IEEE, BCG, Trading Tech + 4 commentators
- ▶ “Business methods are similarly often closer to “big ideas” as they are the basic tools of commercial work.” J. Stevens, *Bilski*
- ▶ Consistent with *Mayo/Alice*’s caution to “tread carefully”
- ▶ Interim Guidance: Not addressed

1 Story About Creativity

United States Patent [19]

Proulx et al.

[11] **Patent Number:** **4,725,156**

[45] **Date of Patent:** **Feb. 16, 1988**

[54] **METHOD AND STRUCTURE FOR
PROPERLY ALIGNING FORMS IN A
PRINTER**

[75] **Inventors:** **Thomas A. Proulx**, Palo Alto;
Thomas H. A. LeFevre, San Jose,
both of Calif.

[73]

[21] **Appl. No.:** **684,652**

[22] **Filed:** **Dec. 21, 1984**

[51] **Int. Cl.⁴** **B41J 13/26**

FOREIGN PATENT DOCUMENTS

91293	6/1982	Japan	400/583.3
107874	7/1982	Japan	400/706
156286	9/1982	Japan	400/583
55755	3/1984	Japan	400/583.3

Primary Examiner—Edgar S. Burr

Assistant Examiner—David A. Wiecking

Attorney, Agent, or Firm—Alan H. MacPherson; Paul J.
Winters; Edel M. Young

[57] **ABSTRACT**

This invention achieves accurate registration of a web of forms such as preprinted checks in a printer controlled by a computer, without requiring skill on the part of the operator or extra equipment for the printer.

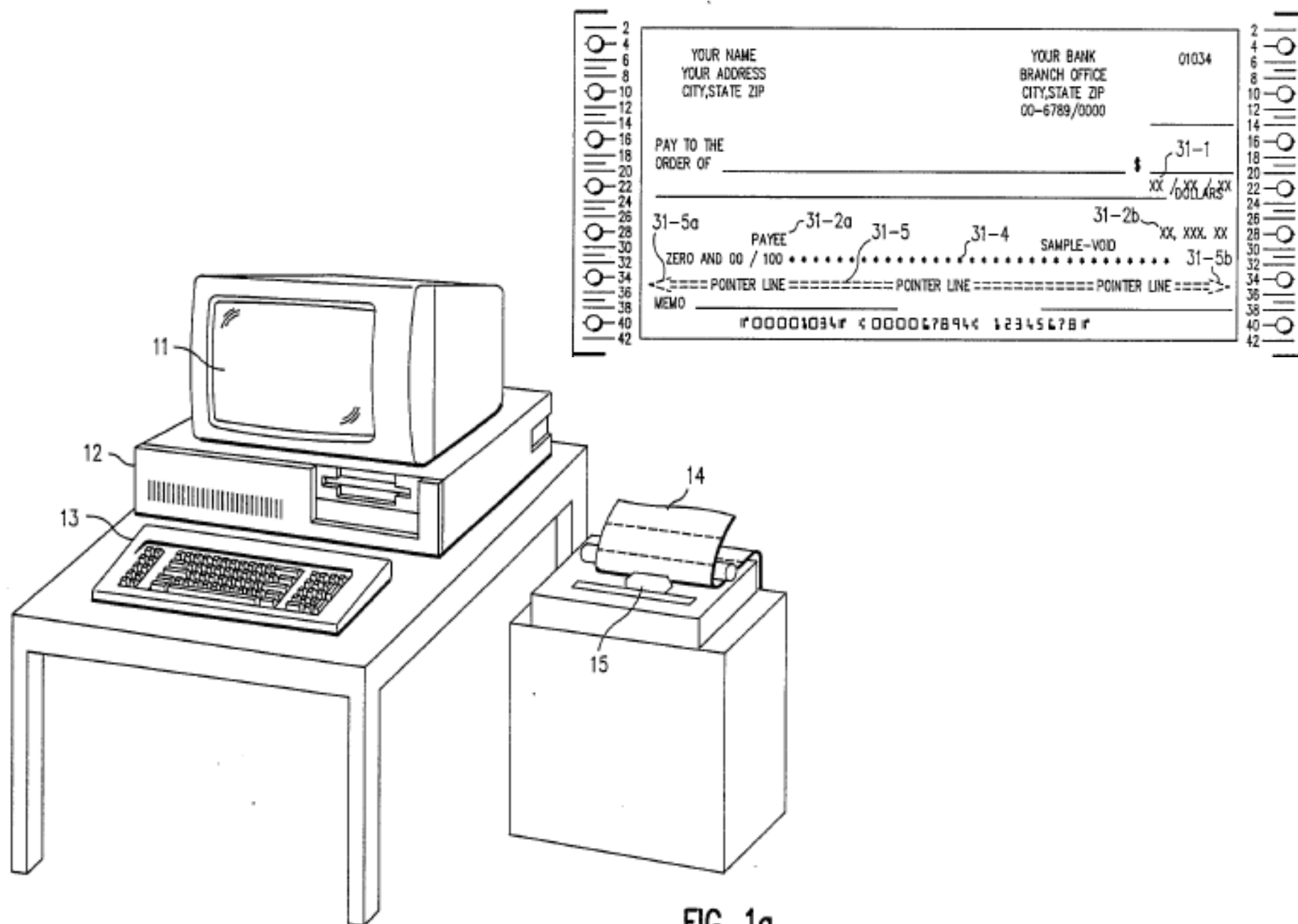


FIG. 1a

1. A method for accurately registering forms to be printed at a print position in a printer controlled by a computer which is operated by an operator with instructions from said computer, each form having the same format as the other forms and having vertically spaced indicia defining lines on said form, comprising:

inserting into said printer a series of said forms so that part of a selected one of said forms is adjacent said print position in said printer;

running a computer program to adjust said forms in said printer with assistance from said operator, said computer program:

causing said printer to place an alignment mark on said selected form of said forms, and

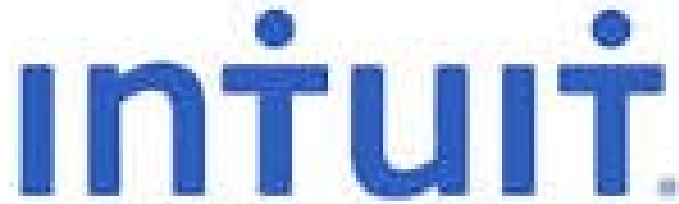
displaying to said operator questions relating to alignment of said selected form;

inputting manually to said computer the indicia defining on which of said lines said alignment mark was placed;

said computer program calculating automatically from said information input to said computer

a printer adjustment to cause said print position in said printer to coincide with a preselected starting position on said forms; and

moving automatically said forms in said printer without need for assistance from said operator so that said printing starts on said forms at said preselected position.



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- ▶ All because of one software patent.
- ▶ That's Creativity. That's Invention.